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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,067	08/20/2001	Steve Brandstetter	P/94-1	6703
7590 05/31/2005			EXAMINER	
Philip M Weiss Esq Weiss & Weiss 310 Old Country Road Suite 201 Garden City, NY 11530			COBURN, CORBETT B	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/933,067	BRANDSTETTER ET AL.	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the linked dispensing units must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to describe the linking of dispensing units. While page 8 has two lines saying that they may be linked, there is absolutely nothing in the specification that tells how this is accomplished. The dispensing unit has no hardware for making such a connection. No networking hardware is disclosed. Nor does Applicant disclose any processor in the dispensing units. Fig 3 discloses software (40), but no processor is disclosed. Examiner has always assumed that the gaming machine provided the processing power for the invention. But this theory is untenable in view of Applicant's most recent amendment unless Applicant's claim is interpreted to mean that dispensing units are linked to game machines, which are then linked to a network. While this appears to be at odds with the plain meaning of the claim language, this is the way that Examiner must interpret the claims in order to have anything like a working system.
4. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Application fails to disclose how a combination of dispensing units has to have a certain number of coins inserted before issuing a ticket. As pointed out above, the individual dispensing units lack the processing power to make such a determination. Nor does the specification describe the software (40) as being able to track coins placed in other game

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machines. Fig 3 clearly shows that the dispensing unit is connected to the hardmeter on a particular machine. There is no disclosure that teaches receiving input from other hardmeters on other machines. Nor is there any disclosure of a means for receiving such input.

Even if there was a disclosed method of receiving input from other hardmeters, there is absolutely no disclosure that tells how this feature is implemented. In fact there is no description that even tells what this limitation means. Presumably, a ticket is issued when a certain number of coins is inserted, but to whom? The last person inserting a coin? The person who inserted the most coins? Randomly? In a predetermined order? None of these questions is answered. There is nothing in the specification that gives us any hint what is done when the correct number of coins is inserted or how this is carried out.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As pointed out above, the specification is silent concerning the meaning of the limitation a combination of dispensing units has to have a certain number of coins inserted before a ticket is dispensed. Since the specification is silent in this regard, it is impossible to determine the metes and bounds of the claims. Examiner will interpret the claims to the best of his understanding.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6, 9, 10, 12, & 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuniewicz (US Patent Number 6,585,589) in view of Quinn. (US Patent Number 3,688,276).

**Claim 1:** Okuniewicz teaches device for paying out a bonus (Col 1, 43-46) to a player playing a gaming machine. (Fig 1) There is a gaming machine (Slot Machine). There is a dispensing unit (Lottery Terminal). Since Okuniewicz teaches that the dispensing unit may dispense a ticket when a present amount of coins are inserted (Col 3, 46-53), there must be a numeric counter for counting the number of coins placed in said gaming machine that counts coins until a ticket is generated. Okuniewicz does not teach visually displaying to the player the number of coins needed to generate a ticket or the number of coins inserted by the player. Nor does Okuniewicz teach resetting the counted coins to zero once a ticket is generated. These are common functions on virtually any modern vending machine.

Quinn, which is also a lottery ticket dispenser, teaches visually displaying to the player the number of coins needed to generate a ticket and the number of coins inserted by the player as well as resetting the counted coins to zero once a ticket is generated. (Fig 1) Such a visible meter allows the player to know how much money he must insert and how much money he has inserted. Clearing the counter lets the player know that if he wants another ticket, he has to put in more money. These features add to user convenience and are, as previously pointed out, extremely well known. It would have

been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz in view of Quinn to visually display to the player the number of coins needed to generate a ticket and the number of coins inserted by the player as well as to reset the counted coins to zero once a ticket is generated in order to add to player convenience.

**Claims 2-4:** Okuniewicz teaches that the dispensing unit may be a retrofit unit for a slot machine (Col 3, 1-4). Okuniewicz teaches that the dispensing unit could be attached to the gaming machine externally (i.e., side-mounted) or mounted internally. (Col 4, 63-66)

**Claim 5:** The gaming machine may include video poker machines (Col 3, 36-42). Video bingo games and video keno games are disclosed as equivalents.

**Claim 6:** The dispensing unit is a self-contained unit that does not affect play or outcome of said gaming machine. (Col 4, 35-43)

**Claims 9, 14:** Okuniewicz dispenses lottery tickets. (Abstract)

**Claim 10:** Okuniewicz teaches that the dispensing units are linked (to the gaming machine which are then linked in a network) so that the combination of dispensing units (i.e., the slot machine/lottery terminal combination) has to have a certain number of coins inserted before a ticket is dispensed. (Col 3, 51) If a certain number of coins is inserted into a single dispensing unit, then it issues a ticket. This meets the limitation of the claim because the certain number of coins is inserted into the combination of dispensing units. Applicant does not claim that the coins must be inserted into different dispensing units within the combination, nor does Applicant's specification support such a limitation.

**Claims 12, 17:** Claim 12 is a combination of claims 1 & 5. Claim 17 is a subset of claim

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1.

**Claim 15:** Okuniewicz teaches holding a drawing to determine a winner of said ticket.

**Claim 16:** Okuniewicz teaches the lottery ticket may be for the Big Game. In the Big Game, a bonus prize is generated from a percentage of total coins placed into all participating gaming machines (i.e., a percentage of money used to buy game tickets).

9. Claims 7, 8, 11, 13 & 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuniewicz and Quinn as applied to claim 1, 12 above, and further in view of Castellano et al. (US Patent Number 5,477,952).

**Claims 7, 13:** Okuniewicz and Quinn teach the invention substantially as claimed. Both contain coin counters, but do not give details of the operation thereof. Okuniewicz bonuses a player based on number of coins played (Col 3, 51) but does not teach that the numeric counter counts coin pulses off of the gaming machine's hard meter. Castellano teaches the method of operation of the coin counters. Castellano teaches that the numeric counter (12) counts coin pulses off of the gaming machine's hard meter (52). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz and Quinn in view of Castellano to have the numeric counter count coin pulses off of the gaming machine's hard meter in order to carry out Okuniewicz and Quinn's suggestion to count the coins entered by the player.

**Claim 8:** Okuniewicz and Quinn teach the invention substantially as claimed. Neither specifically discloses that the numeric counter can count various coin denominations. Castellano specifically teaches discloses that the numeric counter can count various coin denominations. (Fig 1, 21-24) Allowing players to use more than one denomination



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makes it convenient for the player to put more money in the slot machine. This increases profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz and Quinn in view of Castellano to have the numeric counter can count various coin denominations in order to make it convenient for the player to put more money in the slot machine.

**Claims 11, 18:** Okuniewicz teaches that the benefit of the device is the ability to change the criteria for generating a ticket. (Col 3, 1-9) The LIB is a remote unit (i.e., a separate module) for changing the number of coins necessary to generate said ticket.

***Response to Arguments***

10. Applicant's arguments filed 8 March 2005 have been fully considered but they are not persuasive.

11. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is well known to the art that visible coin in meters add to player convenience. People like to know how many coins they have put into a machine and how many more coins they need to put in to make their purchase. Such visible coin in meters are extremely well known to the art, as is the reason for including them.

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12. Applicant states that Castellano fails to teach bonusing a player for the number of coins played. As pointed out in the rejection, this feature is taught by Okuniewicz.

13. Applicant's bald assertion that there is no reason to combine Okuniewicz, Quinn and Castellano is equivalent to a mere assertion of patentability. The motivation to combine is spelled out in the rejection. If Applicant wishes to attack the combination, Applicant must show why the motivation is faulty.

*Notes on Claim Interpretation*

14. In a recent telephone conversation with Applicant's attorney, he lamented the fact that case has gone through at least three RCEs without addressing what Applicant sees as his invention. Applicant's attorney explained the invention as a system that counts the number of times a player plays a slot machine without winning and pays a lottery ticket if the player hasn't won the slot machine game in a certain number of plays. (This was during an informal telephone call to discuss a matter of procedure and did not rise to the level of a formal interview. Examiner realizes that such informal remarks do not impose limits on claim interpretation – i.e., do not act as estoppel – and that a formal interview has mechanisms to prevent misunderstandings.)

In light of this conversation, Examiner has reread both the specification and the claims to see if a change in claim interpretation was warranted. Examiner cannot find anything in the claims that limit the invention to the system described in Applicant attorney's telephone conversation. Furthermore, there is absolutely nothing in the specification that describes such a system. Therefore, if Applicant amended the claims to claim such a system, it would be new matter.

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Even if Applicant filed a Continuation-in-Part to claim this system, the concept is approximately 70 years old. In 1936, the Mill company came out with a Futurity slot machine that paid off if the player played 10 games without a win. The Futurity machine even had a counter similar to the one claims by Applicant. (See Fey, *Slot Machines, A Pictorial History of the First 100 Years*, page 162.) Examiner cannot, of course, discuss claims that are not in the case, but in the interest of speeding resolution of this case, Examiner urges Applicant to review this reference carefully.

Examiner realizes that the examination process can be frustrating. Applicant has a clear vision of what he invented and it may appear that the Examiner is examining everything but that invention. But the Examiner is confined to examining the claims, given the broadest reasonable interpretation in light of the specification. In this case, the claims and the specification support the interpretation given them by the Examiner, but do not appear to support the interpretation urged by Applicant's attorney.

### ***Conclusion***

15. This is an RCE of applicant's earlier Application No. 09/933,067. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fey, *Slot Machines, A Pictorial History of the First 100 Years*, page 162 discloses a slot machine that embodies the invention described by Applicant's attorney.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Jessica Harrison can be reached on (571) 272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Corbett B. Coburn

Examiner

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JESSICA HARRISON  
PRIMARY EXAMINER